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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,984

05/08/2008

Jei Man Ryu

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EXAMINER

PIHONAK, SARAH

ART UNIT

PAPER NUMBER

1627

NOTIFICATION DATE

DELIVERY MODE

02/28/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
IPMatters@arentfox.com
Patent_Mail@arentfox.com

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/584,984	Applicant(s) RYU ET AL.	
	Examiner SARAH PIHONAK	Art Unit 1627	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 February 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-9.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1627

/S. P./
Examiner, Art Unit 1627

Applicants' arguments, with regards to the rejection under 35 USC 103(a) as being unpatentable over Suh, in view of Karsenty et. al., and further in view of Allen et. al., have been fully considered but are not found persuasive, and do not place the application in condition for allowance. The Applicants have argued that the claimed compound, N-hydroxy-4-{5-[4-(5-isopropyl-2-methyl-1,3-thiazol-4-yl)-phenoxy]pentoxy}-benzamidinium 2 methanesulfonic acid salt, would not have been prima facie obvious, because Karsenty et. al. does not teach that di-mesylate salts are preferred. The Applicants have also argued that the Karsenty reference refers to Allen et. al. in mentioning dimesylate salts, and therefore, one of ordinary skill in the art would not have inferred that the dimesylate salt would have been preferred over other salts. The Applicants have further argued that the compounds taught by Karsenty and Allen et. al. are structurally different than the claimed compound, and as such are not applicable to the claimed invention.

The examiner respectfully disagrees. As discussed in the office action dated 10/15/2010, it is acknowledged that Karsenty et. al. teaches di-mesylate salts for the treatment of osteoporosis, but does not explicitly teach that they are preferred. However, Allen et. al. teaches that the dimesylate salts have superior properties, such as good solubility, stability, and they are non-hygroscopic at high humidity levels. Therefore, one of ordinary skill in the art would have been motivated to prepare the di-mesylate salt of N-hydroxy-4-{5-[4-(5-isopropyl-2-methyl-1,3-thiazol-4-yl)-phenoxy]pentoxy}-benzamidinium, because Suh teaches salts of methanesulfonic acid of this compound for treating osteoporosis, while Karsenty et. al. teaches that treatment of bone diseases is accomplished by salts of compounds which modulate neuropeptide Y activity, including di-mesylate salts, and Allen et. al. teaches that the di-mesylate salt of neuropeptide Y ligands have superior properties. As neuropeptide Y ligands and N-hydroxy-4-{5-[4-(5-isopropyl-2-methyl-1,3-thiazol-4-yl)-phenoxy]pentoxy}-benzamidinium are taught by the prior art to treat osteoporosis, and Allen et. al. teaches that the di-mesylate salt exhibits superior properties for agents which are also used to treat osteoporosis, one of ordinary skill in the art would have been motivated to prepare the di-methanesulfonic acid salt of N-hydroxy-4-{5-[4-(5-isopropyl-2-methyl-1,3-thiazol-4-yl)-phenoxy]pentoxy}-benzamidinium, with the expectation that it would also have possessed superior characteristics. The rejection under 35 USC 103(a) was proper and is maintained, for reasons of record. The Applicants have further argued that the salt of the claimed compound is an acid, and not the di-mesylate salt. The examiner notes that the di-mesylate salt is the deprotonated form of di-methanesulfonic acid; it would have been expected that based upon the environment in which the compound was present, that the salt would fluctuate from being protonated or deprotonated.

The terminal disclaimer filed in response to the rejection for obviousness type double patenting over the claims of co-pending application 11/577469 has been approved; therefore, this rejection is withdrawn. The Applicants' arguments presented with regards to the rejection for obviousness type double patenting over the claims of US Patent No. 7,662,840 are similar to those discussed above. The examiner maintains this rejection for the reasons discussed above.